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Date: March 22, 2011 Name: Jasper W. Dockrey, Reg. 33,868 Signature: /Jasper W. Dockrey/

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Hubert MORICEAU et al.
Appln. No.: 10/565,621
Filed: July 25, 2006
For: STACKED STRUCTURE AND
PRODUCTION METHOD THEREOF
Attorney Docket No: 9905/37 (BIF116044US)

Examiner: Reema Patel
Art Unit: 2812
Confirmation No.: 2319

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

The applicants hereby request a pre-appeal review pursuant to the Pre-Appeal Brief Conference Pilot Program set forth in 1296 Off. Gaz. Pat. Office 67 (July 12, 2005). A Notice of Appeal and fee submission is attached hereto.

On November 23, 2010, the Examiner issued a final Office Action for the above-referenced application. In the final Office Action, the Examiner objected to the applicant's submission of a new drawing figure, FIG. 7, submitted with the applicant's amendment and response of July 7, 2010, and objected to the applicants' specification amendment to recognize the new drawing figure. The Examiner further rejected claims 1, 5-8, and 11-26 under 35 U.S.C. §112, first paragraph, and rejected claim 26 under 35 U.S.C. §102(b) over U.S. Pat. No. 6,156,215 to Shimada et al.

The applicants' argument begins at page 2 of this paper.

Those Skilled In The Art Will Understand That The Inventors Had Full Possession Of A Process That Includes At Least Partially Eliminating The Sacrificial Layer To Expose The Surface Portion

Claim 1 recites that the method includes “*a step of at least partly eliminating the sacrificial layer to expose the surface portion such that the surface portion at least partially faces the second plate.*” The Examiner acknowledges that the instant specification contains support for “at least partially eliminating the sacrificial layer so that the plates face each other,” but the Examiner asserts that there is no support for exposing the surface portion (roughened side of first plate). (Office Action, pgs. 4-5). The applicants first point to their certified English translation of their priority French patent application, now of record in the instant application and filed on November 14, 2007. Claim element b) of original claim 1 is reproduced below, as it appeared in the applicants’ priority French patent application No. 0308865 and in their corresponding PCT application No. PCT/FR04/01858.

b) a sacrificial layer (3; 8) is produced on at least a portion of the surface (2) of the first plate (1) and/or the surface (7) of the second plate (5)

Thus, the applicants assert that their original claims recognize that only a portion of the sacrificial layer can be produced on the first or second plate. As noted in MPEP §2163.03, “there is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). Consequently, rejection of an original claim for lack of written description should be rare.”

Further, the applicants disclose an embodiment in which a surface layer has a roughened surface. (Substitute Specification pg. 15, lines 15-20). A sacrificial layer is deposited over the surface layer, and the sacrificial layer is selectively etched to expose the roughened surface layer. (Substitute Specification pg. 16, lines 3-10). The applicants then describe that this is one embodiment in which the surface of a plate is structured. (Substitute Specification, pg. 16, lines 11-17). The specification further describes that

“[i]t is clear that a non-continuous sacrificial layer may be obtained, for example by localized deposition or by etching; this enables areas already opened up to be defined in the stacked structure.” (Substitute Specification, pg. 16, lines 26-29).

Accordingly, the applicants describe a process embodiment in which the stacked structure is made by bringing the plates together where one of the plates has a surface layer that is exposed by selective etching of the sacrificial layer.

According to MPEP §2163.02, “[t]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” In addition to point to their French priority application, the applicants submitted a Rule 132 Declaration with their response of July 7, 2010. In his Declaration, Dr. Renard describes a number of aspects related to MEMS device structure and processing. (Renard Declaration, ¶¶ 7-10). Further, Dr. Renard summaries the problems addressed by the applicants’ inventive method, and cites several portions of the applicants’ specification that describe the claimed process. (Renard Declaration, ¶¶ 11-14). Upon review and analysis, Dr. Renard states that the disclosed process results in a situation in which “when the two silicon plates are bonded together, the sacrificial layer will not extend entirely across the interface between the two plates. Because the sacrificial layer is either selectively formed in certain regions, or portions are removed, the silicon surfaces of the plates will be exposed to each other in certain areas of the interface.” (Renard Declaration, ¶ 15). Thus, Dr. Renard concludes that he understands “the meaning of the term ‘faces’ as it appears in the application as describing a situation in which, because at least part of the silicon oxide layer has been removed, and the structured surface of one plate is open to the other plate, without any intervening layer between the two plates.” (Renard Declaration, ¶ 16).

The applicants assert that, as set forth in Dr. Renard’s Declaration, one skilled in the art would understand the meaning of the word “faces” as used in the applicants’ specification and claims. The phrase “the surface portion at least partially faces the second plate” appearing in claim 1 is understood to mean that

the surface portion is opposite to the second plate and the plates are arranged without any intervening structure, as described above. The applicants assert that, within the context of the process described and claimed, for the surface portion to “face” second plate, the surface portion of the first plate is exposed by the partial elimination of the sacrificial layer.

In support of this rejection, the Examiner also points to FIG. 4 of the applicants’ drawing as somehow foreclosing an embodiment in which the sacrificial layer (3) is partially removed to expose the underlying surface prior to bonding the first and second plates together. (Office Action, pg. 5). Here, the Examiner is improperly restricting the applicants’ written description to a single disclosed embodiment. The applicants assert that the process illustrated in FIG. 4 is only one embodiment of the disclosed process. This is clear from the applicants’ specification, in which the applicants refer to “the embodiments described above,” in the context of further described embodiments. (See, for example, pg. 14, ll. 29-32, pg. 16, ll. 11-32, pg. 17, ll. 14-18). The applicants assert that, given the clear disclosure by the applicants that their process includes multiple embodiments, there is no basis to assert that the applicants were not in possession of the claimed invention as of their original filing date. In view of the written description provided by the applicants’ specification, there is no basis for the instant rejection and the applicants respectfully request that the rejection be withdrawn.

The Introduction Of FIG. 7 And The Corresponding Amendment Of The Specification Does Not Constitute New Matter

To illustrate the subject matter of their original claim, the applicants submitted a new drawing figure and a corresponding amendment of their specification to recognize the new figure. The additional FIG. 7 illustrates the result of partially forming the sacrificial layer (3), or partially removing a portion of the sacrificial layer (3), to form the non-continuous sacrificial layer on the surface (2) of the plate (1). In the Declaration described above, Dr. Renard establishes that one skilled in the art would comprehend the subject matter disclosed the

specification to describe the structure illustrated in FIG. 7. (See, Renard Declaration, ¶¶ 5 et seq.). In view of the disclosed process and the explicit claim language in their original application, and in view of the attached Declaration, the applicants assert that new matter is not introduced by FIG. 7 and the corresponding specification amendment. The applicants respectfully request that the objection be withdrawn.

**Rejection Of Claim 26 Under 35 U.S.C. 102(b) Should Be Withdrawn
Because Shimada et al. Do Not Disclose A Roughened Surface Portion That
At Least Partially Faces The Second Plate**

Shimada et al. disclose a first substrate (1) having a peeling layer (4) overlying the substrate surface and dents (3) in the surface. A light blocking layer (5) partially covers the peeling layer. A second substrate (8) has a mask layer (10) covering a discontinuous surface, and a bonding layer (7) partially covering the mask layer. In the bonded structure illustrated by Shimada et al. in FIG. 1E, the peeling layer (4) and the mask layer (10) remain on facing surfaces of their respective substrates. Shimada et al. do not suggest or disclose at least partially removing either the peeling layer or the light blocking layer. Accordingly, Shimada et al. fail to suggest or disclose a roughened surface portion that at least partially faces a second plate.

The applicants have established that they provide a written description of their pending claims and that claim 26 is novel. Accordingly, the withdrawal of all pending objections and rejections is now earnestly requested.

Respectfully submitted,

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